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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,130

06/27/2007

Seiichi Toki

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22918

7590

10/06/2008

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EXAMINER

WORLEY, CATHY KINGDON

ART UNIT

PAPER NUMBER

1638

MAIL DATE

DELIVERY MODE

10/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/594,130	Applicant(s) TOKI, SEIICHI	
	Examiner CATHY K. WORLEY	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/25/08; 7/28/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed June 25, 2008, has been entered.
2. Claims 1-6 are pending and are examined in the present office action.
3. The text of those sections of Title 35, U.S. Code not included in this office action can be found in a prior office action.

Objections that are Withdrawn

4. The objections to claims 1-6 for minor informalities are withdrawn in light of the Applicant's amendments to the claims.

Specification

5. The abstract of the disclosure remains objected to because the first nine words of the abstract are not a complete sentence. The Applicant amended the abstract, however, the amended first nine words are not a complete sentence. They only provide a subject of the sentence. The Examiner suggests replacing "A" with - - The invention is a - - . Correction is requested. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 103

6. Claims 1-6 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al (JP2001029075, published on Feb. 6, 2001) for the reasons of record stated in the previous Office Action mailed on Feb. 25, 2008. The Examiner relies on a machine translation of this document in order to make this rejection. The Applicant's arguments in the response filed on June 25, 2008, were fully considered but were not found to be persuasive.

The claims are drawn to a method for transforming a monocotyledon by infecting a seed with Agrobacterium.

Tanaka et al teach a method for transforming a rice seed comprising the steps of incubating the seed in a medium containing 2 mg/l of 2,4-D for five days followed by cocultivation with Agrobacterium (see paragraphs 0037 - 0039). They claim transformation with Agrobacterium containing a desired recombination gene (see claim 1).

Tanaka et al do not teach pre-culture for 1 to 3 days.

The only difference between the claimed invention in the instant application and the invention taught in the prior art Japanese application is the number of days of pre-culture for the seeds prior to cocultivation with Agrobacterium. In the absence of any showing of unexpected results, it would be an obvious variant of the prior art invention to reduce the number of days of pre-culture. The Japanese plant claims a method using four or five days of pre-culture (see claim 2), and this

indicates that the 5-day incubation period in the working example is not critical. One of ordinary skill in the art would be motivated to try shorter pre-culture times in order to expedite the procedure.

In the previous Office Action, mailed on Feb. 25, 2008, the Applicant was invited to provide evidence of unexpected results.

The Applicant has provided a post-filing reference by Toki et al (The Plant Journal (2006) Vol. 47, pp. 969-976) that demonstrates the superior results achieved when intact rice seeds were precultured for only one day on medium containing the auxin 2,4-D. The Applicant argues that this result is surprising (see pages 6-7 of the response). The Examiner agrees that this is a surprising result demonstrating superior performance for the precise protocol carried out by Toki et al. However, none of the current claims are limited in scope to a method that utilizes intact rice seeds and subjects the intact rice seed to only 1 day of pre-culture in a medium containing 2,4-D. Therefore, the claims are not commensurate in scope with the showing of a surprising result.

The Applicant is advised that if the limitations in claims 1, 2, 4, and 6 were combined into one claim, than that claim could be allowable.

7. No claim is allowed.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CATHY K. WORLEY whose telephone number is (571)272-8784. The examiner is on a variable schedule but can normally be reached on M-F 10:00 - 4:00, with additional variable hours before 10:00 and after 4:00 with additional variable hours before 10:00 and after 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cathy K. Worley/
Patent Examiner, Art Unit 1638